



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/649,738	08/28/2000	Hulikunta Prahlad Raghunandan	JP920000198US1	7857

7590 12/15/2004

International Business Machines Corporation
Almaden Research Center
650 Harry Road
San Jose, CA 95120

EXAMINER

TRAN, PHILIP B

ART UNIT	PAPER NUMBER
----------	--------------

2155

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/649,738

Applicant(s)

RAGHUNANDAN, HULIKUNTA
PRAHLAD

Examiner

Philip B Tran

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date attached.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. In view of the Appeal Brief filed on 08/23/2004, PROSECUTION IS HEREBY REOPENED. New office action is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Noted that, claims 1-9 are pending.

Claim Objections

2. Claim 1 is objected to because of the following informalities:

In claim 1, line 6, there is an extra word in the phrase "**the said** remote email server" that should be deleted.

In claims 1, 4 and 7, hyphens should be omitted.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 1 recites the limitation "a means to access the said remote email server through network during **the boot up process** using said network adapter" in lines 6-7.

There is insufficient antecedent basis for this limitation in the claim.

Claim 1 recites the limitation "a means to download **the email count** for **the current user** from the remote email server on said network" in lines 8-9. There is insufficient antecedent basis for this limitation in the claim.

Claim 1 recites the limitation "a means to display the email count for the current user in a defined format on **the display** of said computing system" in lines 10-11. There is insufficient antecedent basis for this limitation in the claim.

Claim 3 recites the limitation "... configuration means for configuring **the designated users** of the system during a previous system operation" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

Claim 4 recites the limitation "a method for accessing email count during **the boot up process**" in lines 2-3. There is insufficient antecedent basis for this limitation in the claim.

Claim 4 recites the limitation "downloading **the email count** for **the user** from the remote email server on said network" in lines 6-7. There is insufficient antecedent basis for this limitation in the claim.

Claim 4 recites the limitation "displaying the email count for **the current user** in a defined format on **the display** of said computing system" in lines 8-9. There is insufficient antecedent basis for this limitation in the claim.

Claim 6 recites the limitation "... configuring **the designated users** of the system during a previous operation" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

Claim 7 recites the limitation "to access email count during **the boot up process**" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 7 recites the limitation "computer readable program code means configured for communicating with **the network adapter**" in lines 5-6. There is insufficient antecedent basis for this limitation in the claim.

Claim 7 recites the limitation "computer readable program code means configured for accessing **said remote email server** through network during the boot up process using said network adapter" in lines 7-9. There is insufficient antecedent basis for this limitation in the claim.

Claim 7 recites the limitation "computer readable program code means configured for downloading **the email count for the current user** from the remote email server on said network" in lines 10-11. There is insufficient antecedent basis for this limitation in the claim.

Claim 7 recites the limitation "computer readable program code means configured for displaying the email count for the current user in a defined format on **the display** of said computing system" in lines 12-14. There is insufficient antecedent basis for this limitation in the claim.

Claim 8 recites the limitation "...wherein said computer readable program code means is configured for communicating with the network adapter through **the TCP/IP**

protocol" in lines 1-3. There is insufficient antecedent basis for this limitation in the claim.

Claim 9 recites the limitation "... configuring **the designated users** of the system during a previous system operation" in lines 2-3. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The analysis under 35 U.S.C. 112, first paragraph, requires that the scope of protection sought be supported by the specification disclosure. The pertinent inquiries include determining (1) whether the subject matter defined in the claims is described in the specification and (2) whether the specification disclosure as a whole is to enable one skilled in the art to make and use the claimed invention.

(1) Claims 1, 4 and 7 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The "invention" for the purpose of the first paragraph analysis is defined by the claims. The description requirement is simply that the claimed subject matter must be described in the specification. The function of the description requirement is to ensure that the applicant had possession of the invention on the filing date of the application.

The application need not describe the claim limitations exactly, but must be sufficiently clear for one of ordinary skill in the art to recognized that the applicant's invention encompasses the recited limitations. The description requirement is not met if the application does not expressly or inherently disclose the claimed invention.

Specification does not explicitly describe nor is sufficiently clear for one of ordinary skill in art to recognize the following steps as recited in claims 1, 4 and 7:

- download the email count for the current user from the remote email server on said network.
- display the email count for the current user in a defined format on the display of said computing system.

Claims 1, 4 and 7 are unclear that the one ordinarily skilled in the art cannot recognize the encompassed claim limitations.

(2) Claims 1, 4 and 7 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The enablement requirement necessitates a determination that the disclosure contains sufficient teaching regarding the subject matter claimed as to enable one skilled in the pertinent art to make and use the claimed invention. In essence, the scope of enablement provided to one ordinarily skilled in the art by the disclosure must be commensurate with the scope of protection sought by the claims.

Currently, the most prevalent standard for measuring sufficient enablement to meet the requirements of 112 is that of "undue experimentation". The test is whether, at the time of the invention, there was sufficient working procedure for one skilled in the art to practice the claimed invention without undue experimentation. It is important to note that the test of enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, is it undue. An skilled artisan is given sufficient direction or guidance in the disclosure. Moreover, the experimentation required, in addition to not being undue, must not require ingenuity beyond that expect of one of ordinary skill in the art.

Undue experimentation and ingenuity would be required beyond one ordinarily skilled in the art to practice the following steps as recited in claims 1, 4 and 7:

- download the email count for the current user from the remote email server on said network.
- display the email count for the current user in a defined format on the display of said computing system.

Undue experimentation would be needed to download the email count for the current user from the remote email server on the network during the boot up process and to display the email count for the current user in a defined format on a display of the computing system.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1-9 are rejected under 35 U.S.C 103(a) as being unpatentable over Khanna et al (Hereafter, Khanna), U.S. Pat. No. 6,609,151 in view of Thurlow et al (Hereafter, Thurlow), U.S. Pat. No. 6,457,879.

Regarding claim 1, Khanna teaches in a computing system consisting of a processor, memory storage, input and output devices, a network interface adapter and a basic input/output system (BIOS) for booting, said system being connected to a remote computer [see Fig. 1], characterized in that said BIOS (108) includes a means to communicate with the network adapter (i.e., NIC 116) [see Fig. 1], and a means to access the said remote email server through network during the boot up process using said network adapter (i.e., electronic mail routine in the BIOS) [see Col. 6, Lines 1-10]. Khanna does not explicitly teach email server system and a means to download the

email count for the current user from the remote email server on said network, and a means to display the email count for the current user in a defined format on the display of said computing system. However, Thurlow, in the same field of communication between a client computer and an electronic mail server endeavor, discloses the use of the client email application program interaction with the remote email server system for checking connection upon booting up and downloading email [see Thurlow, Abstract and Col. 7, Lines 4-61 and Col. 14, Lines 45-57]. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to check email upon start-up because it would have enabled the user to configure email count received [see Thurlow, Col. 14, Lines 45-57].

Regarding claim 2, Khanna further teaches a system as claimed in claim 1 wherein the communication with said remote email server (remote computer) is through TCP/IP protocol [see Col. 1, Lines 30-42 and Col. 3, Lines 29-30].

Regarding claim 3, Khanna further teaches a system as claimed in claim 1 further comprising configuration means for configuring the designated users of the system during a previous system operation [see Col. 3, Lines 25-39 and Col. 5, Lines 39-50].

Claims 4-6 are rejected under the same rationale set forth above to claims 1-3.

Claims 7-9 are rejected under the same rationale set forth above to claims 1-3.

Response to Arguments

8. Applicant's arguments have been fully considered but they are not persuasive because of the following reasons:

Khanna teaches in a computing system consisting of a processor, memory storage, input and output devices, a network interface adapter and a basic input/output system (BIOS) for booting, said system being connected to a remote computer [see Fig. 1], characterized in that said BIOS (108) includes a means to communicate with the network adapter (i.e., NIC 116) [see Fig. 1], and a means to access the said remote email server through network during the boot up process using said network adapter (i.e., electronic mail routine in the BIOS) [see Col. 6, Lines 1-10]. Khanna does not explicitly teach email server system and a means to download the email count for the current user from the remote email server on said network, and a means to display the email count for the current user in a defined format on the display of said computing system. However, Thurlow, in the same field of communication between a client computer and an electronic mail server endeavor, discloses the use of the client email application program interaction with the remote email server system for checking connection upon booting up and downloading email [see Thurlow, Abstract and Col. 7, Lines 4-61 and Col. 14, Lines 45-57]. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to check email upon start-up because it would have enabled the user to configure email count received [see Thurlow, Col. 14, Lines 45-57].

*In response to Applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See **In re Keller**, 642F. 2d 413, 208 USPQ 871 (CCPA 1981); **In re Merck & Co.**, 800 F. 2d 1091, 231 USPQ 375 (Fed. Cir. 1986).* Applicant obviously attacks references individually without taking into consideration based on the teaching of combinations of references as shown above. With respect to Khanna, applicant seems to argue points the examiner has already construed Khanna does not explicitly teach while restricting the arguments on the Khanna-Thurlow combined to arguments of no motivation. For example, Khanna teaches the BIOS of the computer (100) may include an electronic mail routine to send network address to the remote computer (130) [see Khanna, Col. 6, Lines 1-10]. However, Thurlow, in the same field of communication between a client computer and an electronic mail server endeavor, discloses the implementation of BIOS in the computer system [see Thurlow, Col. 5, Lines 32-42] and the use of the client email application program interaction with the remote email server system for checking connection **upon booting up** and downloading email [see Thurlow, Abstract and Col. 7, Lines 4-61 and Col. 14, Lines 45-57]. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to check email upon start-up because it would have enabled the user to configure email count received [see Thurlow, Col. 14, Lines 45-57].

*In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. See **In re Nomiya, 184 USPQ 607 (CCPA 1975)**. However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. See **In re McLaughlin, 170 USPQ 209 (CCPA 1971)**. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. The conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference. See **In re Bozek, 163 USPQ 545 (CCPA) 1969**. Every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein. See **In re Bode, 193 USPQ 12 (CCPA 1977)**. In this case, the reason for combining reference Khanna and Thurlow is that to check email upon start-up because it would have enabled the user to configure email count received [see Col. 14, Lines 45-57].*

In response to applicant's arguments, the recitation accessing the email information by the BIOS during the BIOS boot up process has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a

*process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See **In re Hirao**, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and **Kropa v. Robie**, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).*

*In response to applicant's arguments that the present invention involves checking and displaying an email count during the BIOS boot process. This enables **displaying email count very quickly upon power up**. This could mean not even having to wait for the BIOS boot process to finish. In addition, applicant repeatedly argued that Khanna, like Thurlow, does not concern **speedy access to and display of an email count**, as does the present invention. *This feature on which the Applicant relies are not in the claims. It is the claims that define the claimed invention, and it is claims, not specifications that are anticipated or unpatentable. See **Constant v. Advanced Micro-Devices Inc.**, 7 USPQ2d 1064.**


Therefore, the examiner asserts that the cited prior arts properly teach or suggest the subject matter broadly recited in independent claims. Claims 2-3, 5-6 and 8-9 are rejected at least by virtue of their dependency on independent claims and by other reasons set forth above. Accordingly, rejections to claims 1-9 are respectfully maintained as shown above.

9. A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS ACTION IS SET TO EXPIRE THREE MONTHS, OR THIRTY DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION. FAILURE TO RESPOND WITHIN THE PERIOD FOR RESPONSE WILL CAUSE THE APPLICATION TO BECOME ABANDONED (35 U.S.C. § 133). EXTENSIONS OF TIME MAY BE OBTAINED UNDER THE PROVISIONS OF 37 CAR 1.136(A).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip Tran whose telephone number is (571) 272-3991. The Group fax phone number is (703) 746-7239.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T. Alam, can be reached on (571)-272-3978.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.


Philip B. Tran
Art Unit 2155
Dec 02, 2004